UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,609	10/14/2003	Richard B. Mindlin	413333	2912

30954 7590 10/18/2004

LATHROP & GAGE LC
2345 GRAND AVENUE
SUITE 2800
KANSAS CITY, MO 64108

EXAMINER	
CHAMBERS, MICHAEL S	
ART UNIT	**PAPER NUMBER**
3711	

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/684,609	MINDLIN, RICHARD B.	
	Examiner	Art Unit	
	Mike Chambers	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Terminal Disclaimer

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c). The attorney signing the Terminal Disclaimer is not an attorney of record in this application therefore it has not been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> **The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.**

Claims 7 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 7 and 8 has broadened the limitation by changing the terminology from "onto" to "adjacent". The term "adjacent" is significantly broader than the term "onto" and implies structure well beyond that disclosed in the applicants disclosure, which includes the claims as originally filed. This term "adjacent" clearly is not supported and presents new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> **(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

Claims 1, and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien in view of Florian. O'Brien discloses a selectively repositionable foot positioning member (60), a support mat (10), and a selectively repositionable club positioning member (26 or 24, The club positioning device (26) may be a separate article which may be placed on the mat. If item 26 is indicia on the mat, the method step of "placing a club positioning member" is assumed to be the placement of the teeing position and the ball which acts as club positioning member).

However it fails to disclose the use of a mirror. Florian discloses the use of a mirror (8-b). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the device of Florian with the apparatus of O'Brien in order to correctly train golfers in the proper foot position and head position. The step of placing the mirror on the mat surface would have been obvious to one of ordinary skill in the art in order to use the device in the proper fashion.

As to claim 3 : Florian discloses that the use of an instruction manual is well known in the art (1:12-18). Providing a training manual would have been obvious to one

of ordinary skill in the art at the time of the invention to have employed an instruction manual in order to correctly train golfers in the proper foot position and head position.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien in view of Florian as applied to claim 1 and further in view of Durso. The cited art of claim 2 fails to clearly disclose the use of an instructor. Durso discloses it is well known in the art to use professional when using golf instruction devices (6:51-55). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the method disclosed by Durso with the apparatus of O'Brien in order to correctly train novice golfers in the proper foot position and head position.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Brien in view of Durso. O'Brien discloses an instructional device having markers being adjustable for an individual user (fig 1,item 60,26, .). O'Brien discloses the elements of claim 4, however it fails to disclose the step of having the instructor position the markers. Durso discloses it is well known in the art to use professional when using golf instruction devices (6:51-55). It would have been obvious to one of ordinary skill in the art at the time of the invention to have had the instructor position the markers because the instructor is more knowledgeable about correct positions than the student.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over McDevitt in view of Florian. McDevitt discloses the elements of claim 5, however it fails to disclose the use of a mirror. Florian discloses the use of a mirror. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed

the device of Florian with the apparatus of McDevitt in order to correctly train golfers in the proper foot position and head position. The step of placing the mirror on the mat surface would have been obvious to one of ordinary skill in the art in order to use the device in the proper fashion.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over McDevitt in view of Latella. McDevitt discloses the elements of claim 6, however it fails to clearly disclose the use of an instructional manual. The inclusion of instructions of how to use a device is well known in the art. Latella discloses the use of an instructional manual (28:25-33). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the method of including instructions as disclosed by Latella with the device of McDevitt in order to insure the device was used in the proper manner.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/127,621. The method of use claimed in this application would also be used in the co-pending application.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

Applicant's arguments filed 08/12/04 have been fully considered but they are not persuasive. The additional limitation of a removable club positioning member does not avoid the cited art. The ball tee is moveable and broadly represents a club positioning member.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 703-306-5516. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6500075*5294124*4164352* 5839968

Michael Chambers
Examiner
Art Unit 3711

October 12, 2004

GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700